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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,350	03/22/2001	Bruce Dickson	RSW920010015US1	3665
7590 07/08/2004			EXAMINER	
Esther H. Chong, Esquire Synnestvedt & Lechner LLP 2600 Aramark Tower 1101 Market Street Philadelphia, PA 19107-2950			DURAN, ARTHUR D	
			ART UNIT	PAPER NUMBER
			3622	
DATE MAILED: 07/08/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/814,350

Applicant(s)

DICKSON ET AL.

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/19/04, 3/22/04.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-25 have been examined.

Claim Objections

2. Claims 18, 25 objected to because of the following informalities. Claims 18 and 25 are stated as being dependent upon claim 18 and 25, respectively. However, claim 18 cannot be dependent upon itself. Examiner will continue and assume that claims 18 and 25 were intended to be stated as dependent upon claims 14 and 24, respectively. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-3, 6, 7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims are rejected under 35 U.S.C. 101 because these claims have no connection to the technological arts. The method claims do not specify how the claims utilize any technological arts. For example, no network or server is specified. To overcome this rejection, the Examiner recommends that the Applicant amend the claim to specify or to better clarify that the method is utilizing a medium or apparatus, etc within the technological arts. Appropriate correction is required.

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As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In*

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re Toma, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but

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rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the current application, no technological art (i.e., computer, network, server) is being utilized by claims 1-3, 6, 7. For example, the wireless communication device could be a simple plastic cone for voice amplification with a shopping list attached to it. The other steps of obtaining, correlating, and providing could be performed by a human without utilizing the technological arts. At least one step of the body of the claims must explicitly utilize the technological arts. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

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subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 6, 7, 9-11, 14-16, 18-21, 24, 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Barnett (6,321,208).

Claim 1, 9, 19: Barnett discloses a method, system, computer program product for providing personalized coupons to a customer at the beginning of the customer's shopping process, the method comprising the steps of:
obtaining a current shopping list from a wireless communication device of the customer (col 10, lines 16-25; col 10, lines 43-47; col 13, lines 35-45; Fig. 8; col 6, lines 42-47);
correlating the current shopping list with an available coupon list to identify personalized coupons for the customer (col 10, lines 22-30); and
providing the personalized coupons to the customer at the beginning of the customer's shopping process (col 10, lines 24-30; col 13, lines 24-35).

Barnett further discloses an interface (Fig. 1; Fig. 6; col 8, lines 11-14).

Claim 2, 10, 20: Barnett discloses the method, system, computer program of claims 1, 9, 19, and further discloses that the correlating step includes:
comparing items identified in the current shopping list with the available coupon list (col 10, lines 16-30); and
designating coupons directly relevant for said items as the personalized coupons if the comparison results indicate at least one match (col 10, lines 22-26).

Claim 3, 11, 21: Barnett discloses the method, system, computer program of claims 2, 10, 20.

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Barnett further discloses designating coupons related to said items as the personalized coupons if the comparison results indicate no match (col 12, lines 44-50; col 13, lines 26-31).

Claim 6, 15, 24: Barnett discloses the method, system, computer program of claims 1, 14, 19, further comprising:

obtaining customer information from the wireless communication device (col 7, line 60-col 8, line 2);

obtaining previous purchase records of the customer based on the customer information (col 8, lines 17-20).

Claim 7, 16, 25: Barnett discloses the method, system, computer program of claim 6, 15, 24, and further discloses that the correlating step correlates the current shopping list and the previous purchase records with the available coupon list to identify the personalized coupons (col 8, lines 14-20; col 10, lines 16-30).

Claim 14: Barnett discloses the system of claim 9, further comprising:
a first database for storing the available coupon list (Fig. 10); and
a second database for storing purchase records of a plurality of shoppers in the system (col 8, lines 16-20).

Claim 18: Barnett discloses the system of claim 14, and further discloses that at least one of the correlation module, the first database and the second database is located remote from said front location of the store (Fig. 1; col 12, line 65- col 13, line 10).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4, 12, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnett (6,321,208) in view of Bull (6,208,975).

Claim 4, 12, 22: Barnett discloses the method, system, computer program of claims 1, 9, 19. Barnett discloses a variety of communication devices that can utilize that can utilize wireless communications (col 8, line 51-60; col 13, lines 35-45; col 6, lines 42-47).

Barnett does not explicitly disclose that the wireless communication device is a personal digital assistant, a mobile phone, or a two-way pager carried by the customer.

However, Bull discloses that a wireless communication device can be a personal digital assistant, a mobile phone, or a two-way pager carried by the customer (col 4, lines 15-20) and the presentation of coupons (col 4, lines 20-25).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Bull's variety of wireless devices to Barnett's wireless device with varying characteristics. One would have been motivated to do this in order to provide a flexible range of devices that the customer can utilize to attain coupon information.

6. Claims 5, 13, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnett (6,321,208) in view of Rothschild (6,651,053).

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Claim 5, 13, 23: Barnett discloses the method, system, computer program of claims 1, 9, 19. Barnett does not explicitly disclose that, in the obtaining step, the current shopping list is obtained from the customer's wireless communication device using Bluetooth techniques or infrared communication techniques.

However, Rothschild discloses that shopping list related information can be obtained from a customer's wireless communication device using Bluetooth techniques or infrared communication techniques (col 3, lines 58-col 4, line 5).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Rothschild's varying wireless communication protocol to Barnett's wireless communication protocol. One would have been motivated to do this in order to provide increased flexibility as to how wireless communications can be achieved.

7. Claims 8, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnett (6,321,208).

Claim 8: Barnett discloses the method of claim 6.

Barnett does not explicitly disclose pre-storing purchase records of a plurality of customers using Point-of-Sale (POS) terminals.

However, Barnett discloses analyzing purchases at a POS terminal (col 2, line 64-col 3, line 2), storing and tracking user purchasing history at a retail store (col 8, lines 16-20), and that customer related information can be stored at a POS terminal (col 11, lines 39-44).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Barnett's POS terminal that can store customer related information

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can be utilized to pre-store the customer purchase information. One would have been motivated to do this in order to provide a convenient place and way to capture the customer purchase information.

Claim 17: Barnett discloses the system of claim 14.

Barnett further discloses an interface and coupon generator (kiosk) that can be located at a retail store (col 3, lines 35-44).

Barnett does not explicitly disclose that the interface or kiosk is located at the front of the store.

However, Barnett discloses that the coupon generator can be located at a checkout terminal (col 2, line 64-col 3, line 2).

It is obvious that checkout terminals can and are often placed at the front of the store.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Barnett's kiosk located at a retail store can be located at the front of the retail store. One would have been motivated to do this in order to provide coupons at a noticeable or convenient location for the customer.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a. Mothwurf (6,578,735) discloses the utilization of Bluetooth and infrared protocol in information exchange concerning shopping and coupons.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Arthur Duran
Patent Examiner
6/29/04